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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,851	11/02/2001	James E. Moon	989_001DIV2	9771
7590	04/30/2004		EXAMINER	
Christopher R. Pastel WALL MARJAMA & BILINSKI, LLP Suite 400 101 South Salina Street Syracuse, NY 13202			OLSEN, ALLAN W	
			ART UNIT	PAPER NUMBER
			1763	
			DATE MAILED: 04/30/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/003,851	MOON ET AL.
	Examiner Allan Olsen	Art Unit 1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6,24 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 is/are withdrawn from consideration.
- 5) Claim(s) 6,24 and 28-30 is/are allowed.
- 6) Claim(s) 27 is/are rejected.
- 7) Claim(s) 31 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Newly submitted claims 32-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: New claim 32 is similar to originally filed claim 6 except, as stated by Applicant, "claim 32 emphasizes silicon etching as the intervening process step as opposed to thermal oxidation". Claim 6 is directed to a process that involves thermal oxidation. Applicant indicated that claim 6 is based upon the Delayed-LOCOS technique. Upon replacing the thermal oxidation step of claim 6 with the silicon etching step of new claim 32, it can no longer be said that the method is based upon the Delayed LOCOS technique. Rather, claim 32 appears to be based upon the Latent-Masking technique.

The parent application (09/9334,408) included claims directed to methods that relied upon three different techniques. Applicant identified these three techniques as: SMILE; Delayed-LOCOS; and Latent Masking. The parent application also included claims that were directed to various combinations of these three techniques. A restriction requirement was imposed in the parent application. In the restriction requirement, the claims were grouped according to the particular technique or combination of techniques the claimed methods relied upon. Applicant's election in the parent application was made without traverse. Applicant subsequently filed 6 divisional applications with each divisional application being directed to one of the non-elected inventions of 09/9334,408. The Preliminary amendment filed in this application included remarks (see page 4) that associates claim 6 with the Delayed LOCOS technique and

claims 1-3 with the Latent Masking technique. Claims directed to the Delayed-LOCOS technique are being pursued in this application. Like newly filed claim 32, claims 1-3 of the parent application are directed to a method that uses the Latent Masking technique. These claims were the subject matter of divisional application 10/004463.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claim 31 is objected to because some words appear to have been omitted. Claim 31 recites "...and silicon etching silicon said first and second opposing surfaces of said substrate."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description and enablement requirements. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention nor is it described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

Originally filed claim 26 recites, "said step of removing said ...pad oxide is performed as an unmasked etch". By the amendment filed April 14, 2004, the subject matter of claim 26 has been incorporated into claim 6. Claim 27 requires the provision of a shadow mask, however, claim 6 upon which claim 27 is dependent, includes a limitation that dictates an unmasked etch process. There is no disclosure that pertains to or that enables one to perform an unmasked etch upon a masked portion of a substrate.

Allowable Subject Matter

Claims 6 and 24, 28 and 29 are allowed and claim 31 is allowable except for the above noted objection.

Conclusion

Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Olsen whose telephone number is 571-272-1441. The examiner can normally be reached on M-F 1-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Mills can be reached on 571-272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allan Olsen
Primary Examiner
Art Unit 1763

A handwritten signature in black ink, appearing to read "Allan Olsen".